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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,251	11/08/2001	Akira Kuriyama	35.G2932	5033
5514	7590	09/17/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MAYEKAR, KISHOR	
			ART UNIT	PAPER NUMBER
			1753	
DATE MAILED: 09/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/986,251

**Applicant(s)**

KURIYAMA ET AL.

**Examiner**

Kishor Mayekar

**Art Unit**

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-19,21-54 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) 28-54 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-19,21-27 and 57-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 July 2004 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3, 6-19, 21-27 and 57-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The independent claims 1 and 27 now add a limitation that the wavelength of the light reflected into the first case is from 300 to 500nm. The added limitation constitutes a new matter because there is no support for it except for the light having a wavelength of from 300-500 nm and the use of a light reflector.

4. Claims 1, 3, 6-19, 21-27 and 57-59 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the light has a wavelength of 300-500 nm, does not reasonably provide enablement for the same wavelength for the reflected light even though it discloses the use of a light reflector. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

### ***Claim Objections***

5. Claim 24 is objected to because of the incomplete rewritten of the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3, 21-27 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over STROBBEL et al. (6,610,258), a reference cited in a previous Office action. The reference's invention is directed to a device for purifying a fluid with photonic pulses. The reference discloses that the device is particularly adapted for treating fluid such as water (col. 1, lines 16-18) and the device comprises the quartz tube adapted for allowing the fluid to flow therethrough, a light source inside the tube, a light reflector positioned outside the tube (Fig. 3) wherein the light source is a xenon lamp emitting a photonic radiation ranging from low UV to unbroken infrared (col. 2, lines 9-17). The difference between the reference and the above claims is the intended use of the device. The subject matter as a whole would have been obvious to one having ordinary skill in the art at

the time the invention was made to have modified the reference's teachings because it has been held on the intended use of a device that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

As to the subject matter of claims 22 and 23, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings because the manner in which an apparatus operates is not germane to the issue of patentability of the apparatus itself. *Ex parte Wikdahl* 10 USPQ 2d 1546 (BPAI 1989); *Ex parte McCullough* 7 USPQ 2d 1889 (BPAI 1988); *In re Finterswalder* 168 USPQ 530 (CCPA 1971); *In re Casey* 152 USPQ 235 (CCPA 1967).

As to the subject matter of claim 57, the provision of a vessel connected to the tube, the provision would have been within the skill of ordinary skill in the art because the water to be treated is stored in or came from a container and this would result in a continuous treating operation of the water from a container to the tube.

8. Claims 6-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over STROBBEL '258 as applied to claims 1, 3, 21-27 and 57 above, and further in view of HIROSE et al. (3,924,139). The difference between STROBEL and the instant claims is the provision of an air supplier, a functional water supplier and an aeration means. HIROSE shows all of the provision in an apparatus for purifying water (abstract; Fig. 8; and col. 5, lines 47-53). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as shown by HIROSE because this would result in an apparatus with a complete treatment of water.

9. Claims 27, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over DUNN et al. (5,900,211), another reference cited in a previous Office action. The reference is directed to a device for deactivating microorganism in water. The reference discloses that the device comprises all the structures as claimed wherein the light is a xenon lamp emitting light of wavelength between 170 to 2600 nm (Fig. 2; paragraph crossing cols. 8 and 9 and col. 7, lines 58-61). The difference between the reference and the above claims is the intended use of the device. The subject matter as a whole would have been

obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings because it has been held on the intended use of a device that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

### ***Response to Arguments***

10. Applicant's arguments filed 19 July 2004 have been fully considered but they are not persuasive because of the rejections as set forth in the above paragraphs.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the



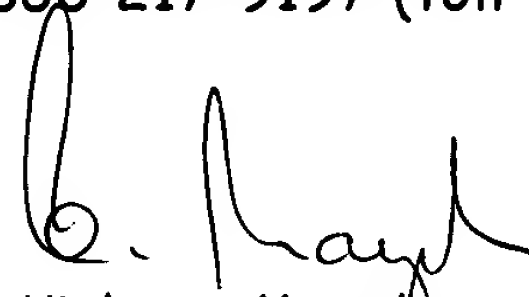
advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kishor Mayekar  
Primary Examiner  
Art Unit 1753